

**Remarks:**

The above amendments and these remarks are responsive to the final Office action dated September 20, 2005. Claims 1, 3-20 and 22-27 are pending in the application. In the Office action, the Examiner rejected claims 3-8 under 35 U.S.C. § 112, second paragraph. Additionally, the Examiner rejected claims 1, 3-20 and 22-27 variously under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) based on Tomida et al. (U.S. Patent No. 6,652,086), Bruce-Sanders (U.S. Patent No. 4,429,478), Cotter (U.S. Patent No. 3,873,769) and Tadokoro et al. (U.S. Patent No. 4,819,078). In view of the amendments above, and the remarks below, applicants respectfully request reconsideration of the application and allowance of the pending claims.

**Rejections under 35 U.S.C. § 112**

Claims 3-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the examiner points out that the limitation "the presentation system of claim 2" in claims 3 and 4 lacks sufficient antecedent basis because claim 2 does not exist. Applicants have amended claims 3 and 4 to depend from claim 1. Thus, applicants request the withdrawal of the rejection of claims 3-8 under 35 U.S.C. § 112.

**Rejections under 35 U.S.C. § 102**

Claims 1, 23 and 24 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tomida et al. (U.S. Patent No. 6,652,086). In view of the Examiner's citing of Tomida et al., applicants submit herewith a Declaration Under § 1.131, demonstrating applicants' invention prior to the effective date of Tomida et al. (October 6, 2000). Tomida et al. thus is rendered unavailable as prior art, and

Page 6 - AMENDMENT  
Serial No. 09/892,422  
HP Docket No. 10005234-1  
KH Docket No. HPCB 312

applicants respectfully request that the rejections of claims 1, 23 and 24 under 35 U.S.C. § 102(e) based on Tomida et al. be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1 and 12-17 are rejected under 35 U.S.C. § 103 as being obvious under Bruce-Sanders (U.S. Patent No. 4,429,478) in view of Cotter (U.S. Patent No. 3,873,769). The Examiner suggests that it would have been obvious to one of ordinary skill in the art to incorporate one print head moving along a rail instead of multiple stationary print heads. In particular, that it would be easier to control one printhead, and would be less expensive to buy one printhead, as opposed to a plurality of printheads. Additionally, that one printhead would be less of a waste of resources, would require less monitoring and would be easier to replace and fix that printhead, as opposed to a plurality of printheads. Moreover, that the printing apparatus would be smaller, lighter, and less prone to errors with one printhead, as opposed to a printing apparatus with a plurality of printheads. Finally, that the printing apparatus would be similar to the use of one black cartridge in ink jet printers if only one printhead is used, instead of a plurality of printheads.

Applicants traverse the rejection, and suggest the Examiner has failed to establish the *prima facie* obviousness of the rejected claims. *Prima facie* obviousness can only be established where there is some suggestion or incentive in the prior art itself to combine or modify the cited references as suggested by the Examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art also suggests the desirability of the modification. In this instance, the Examiner has failed

Page 7 - AMENDMENT  
Serial No. 09/892,422  
HP Docket No. 10005234-1  
KH Docket No. HPCB 312

to identify any specific suggestion or incentive within the cited references themselves that would motivate one of ordinary skill to modify the references.

In particular, the cited references fail to suggest that it would be less expensive to buy one printhead, as opposed to a plurality of printheads as used by Bruce-Sanders. Additionally, applicants note that the presumed simplicity of having a single printhead may impact the complexity, size, weight, and frequency of errors of the accompanying controller. Moreover, the cited references fail to suggest that one printhead would be less of a waste of resources, would require less monitoring and would be easier to replace and fix that printhead, as opposed to a plurality of printheads. Finally, the cited references fail to suggest that the printing apparatus should be modified to be similar to the use of one black cartridge in ink jet printers.

The Bruce-Sanders controller is described as only tracking the position of the carriage 12 to the right and left, as the vertical position of each printhead is fixed (see for example col. 7, line 50 to col. 8, line 36), and each printhead need only be directed to print pixels in the corresponding horizontal line. In contrast, the controller of Cotter is required to track the position of each pixel in both the X and Y axis, and control a single printhead to apply each pixel in the image. The references, singly or in combination, fail to provide a specific suggestion or motivation to modify the printheads of Bruce-Sanders to use a printhead adapted to move along a traverse rail.

For at least these reasons, the Examiner has failed to establish the *prima facie* obviousness of the subject matter of claims 1 and 12-17. In view of the above amendments and remarks, applicants request the withdrawal of the rejection of claims 1 and 12-17 under 35 U.S.C. § 103.

Page 8 - AMENDMENT  
Serial No. 09/892,422  
HP Docket No. 10005234-1  
KH Docket No. HPCB 312

Claims 9-11, 25 and 26 are rejected under 35 U.S.C. § 103 as being obvious over Tomida as applied to claims 1 and 23 above, and further in view of Tadokoro et al. (U.S. Patent No. 4,819,078). As discussed above, applicants submit herewith a Declaration Under § 1.131, demonstrating applicants' invention prior to the effective date of Tomida et al. (October 6, 2000). Tomida et al. thus is rendered unavailable as prior art, and applicants respectfully request that the rejections of claims 9-11, 25 and 26 under 35 U.S.C. § 103 based on Tomida et al. be withdrawn.

Claims 18-20, 22 and 27 are rejected under 35 U.S.C. § 103 as being obvious over Tomida in view of Tadokoro et al. As discussed above, applicants submit herewith a Declaration Under § 1.131, demonstrating applicants' invention prior to the effective date of Tomida et al. (October 6, 2000). Tomida et al. thus is rendered unavailable as prior art, and applicants respectfully request that the rejections of claims 18-20, 22 and 27 under 35 U.S.C. § 103 based on Tomida et al. be withdrawn.

Page 9 - AMENDMENT  
Serial No. 09/892,422  
HP Docket No. 10005234-1  
KH Docket No. HPCB 312

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Walter W. Kamstein  
Registration No. 35,565  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679  
Attorney for Applicants

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner L. Divine, Group Art Unit 2624, Assistant Commissioner for Patents, at facsimile number (571) 273-8300 on November 21, 2005.



Christie A. Doolittle

Page 10 - AMENDMENT  
Serial No. 09/892,422  
HP Docket No. 10005234-1  
KH Docket No. HPCB 312